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**REMARKS**

Claims 1-11 are currently pending in the subject application and are presently under consideration. Claims 12-40 have been withdrawn from consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

**I. Rejection of Claims 1, 5, 8 and 9 Under 35 U.S.C. §102(e)**

Claims 1, 5, 8 and 9 stand rejected under 35 U.S.C. §102(e) as being anticipated by Hoang *et al.* (U.S. 6,499,052). It is respectfully requested that this rejection be withdrawn for at least the following reason. Hoang *et al.* does not teach or suggest each and every limitation as recited in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject invention generally relates to creating an electronic shopping list (e.g., a list of references to items) for a user and utilizing this list to purchase items for the user over the Internet (*See Application*, p.2, ll.9-11). The systems and methods of the present invention provide a user interface that enables the user to create a personalized list of references to items (e.g., offers, product categories, products from merchants, products from manufacturers...) by electronically selecting and adding such items to their list. (*See Application*, p.2, ll.11-17). This list of references, as well as other users' lists, is stored within an item list database (*See Application*, p.2, ll.17-18) and information related to items is stored within an item information database(s) (*See Application*, p.6, ll.7-17). In general, an owner of an item list or a customer who intends on purchasing an item for this owner can request the stored list. On request, an interface component utilizes item references from the stored list to extract related item data from the item information database and employs the extracted data to present a list of items to a requester. (*See Application*, p.7, ll.5-10).

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Independent claim 1 recites *at least one database holding information with respect to items and an item list database that stores at least one item list that includes a reference to at least one item associated with the information stored in the at least one database*. Claim 1 also recites an interface component that obtains item references from the item list database in response to a request to display the item and utilizes the references to extract related data from the information database(s). The extracted data is utilized to return a list of requested items and item information to the requestor. Hoang *et al.* does not describe, teach or suggest such claimed aspects. Rather, Hoang *et al.* is directed to two or more separate, independent gift registry databases; a universal gift registry database located at the local commerce site and a gift registry database located at the remote merchant site. (Col.7, ll.55-60). Hoang *et al.* does not suggest utilizing one or more references obtained from a gift registry database to extract information from the other gift registry database.

Hoang *et al.* is directed to a system for referencing remote merchant websites through a central, local commerce site, also referred to as the remote merchant integration server (RMIS). (Col.2, ll.60-62). The RMIS or local commerce site acts as an interface between users and remote merchant sites, relaying and transforming user requests and merchant responses. (FIGs. 1 and 3). The Office Action contends that the gift registry database in the remote merchant website and the universal gift registry located at the local commerce site implement the at least one database holding information with respect to items and the item list database of the subject invention. (See Office Action dated June 9, 2005, p.3). The Office Action also contends that steps 340 and 350 of FIG. 3, a flowchart of the electronic commerce method and system, constitute an interface component that utilizes the reference obtained from the item list database as a key into the at least one database and searches the at least one databases for the referenced item. (See Office Action dated June 9, 2005, p.3). However, steps 340 and 350 of FIG. 3 represent the general process of sending a user request to a merchant site and receiving a merchant response from a merchant site. (See FIG. 3 and Col.10 ll.17-37). There is no indication that the user request and response include either a reference used to extract item information for a database or the results of a search of a database. In fact, Hoang *et al.* appears to teach against using a reference obtained from one gift registry database to search the other gift registry database. Hoang *et al.* discloses adding items to the universal gift registry database instead of or in place of adding items to the gift registry database at the remote merchant site.

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(Col.7, ll.54-60). The gift registry database at the remote merchant site and the universal gift registry database at the local commerce site are separate and mutually exclusive. Accordingly, Hoang *et al.* does not contemplate retrieving item information from the gift registry database at the remote merchant site based upon references retrieved from the universal gift registry database.

The Office Action also suggests that step 318 of FIG. 3 constitutes accessing the item list database to obtain the reference from the at least one item list. (See Office Action p.3). However, step 318 represents retrieving "a cookie associated with the user client and the remote merchant site, if the user client is not a first-time visitor to the local commerce site." (Col.9, ll.56-59). According to Hoang *et al.*, the cookie may include a "unique identification code identifying the user client to the local commerce site." (Col.6, ll.5-17). Hoang *et al.* does not disclose or suggest including a list of item references in the cookie database.

Hoang *et al.* does not contemplate a component that retrieves item references from one database in response to a user request, utilizes the retrieved references to extract item-related data from a different database(s), and employs the extracted data to create and provide a user with a list of requested items, as recited in the subject claim.

The use of a different database(s) to store item information as disclosed in the subject invention provides several advantages. For example, the item information databases may store item information for items not specifically referenced by item lists in the item list database. Consequently, adding an item to an item list requires simply adding a reference to the item list for an item already residing in the database, rather than retrieving item information from the merchant website. (See Application p.12, ll.1-7). The use of one or more databases containing item information is particularly useful in connection with the gift finder feature. The gift finder is able to search the databases using user attributes to generate alternate items that may be of interest to the user. The gift finder is not limited to items already referenced by existing item lists and does not need to retrieve item information from merchant sites. (See Application p.8, ll.17-24).

Claims 5, 8 and 9 depend from claim 1. As discussed *supra*, Hoang *et al.* does not teach or suggest all limitations of claim 1. For at least these reasons, the rejection to claims 5,8 and 9 should be withdrawn.

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## **II. Rejection of Claims 2-4 Under 35 U.S.C. §103(a)**

Claims 2-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hoang *et al.* in view of official notice of certain statements. Withdrawal of this rejection is respectfully requested for at least the following reasons. Claims 2-4 depend from claim 1. As discussed *supra*, Hoang *et al.* does not teach or suggest all limitations of claim 1. The statements of which the Office Action takes official notice do not make up for the aforementioned deficiencies of Hoang *et al.* For at least these reasons, the rejection to claims 2-4 should be withdrawn.

Claim 2 recites an *interface component joins items from the at least one database and degrades the joined items as records are removed from any of the at least one database*. As disclosed in the subject application, when an item in a user's item list is removed from a database(s), the data can be degraded to provide a user with an alternate item from the database(s) and/or another database(s) such as a best available item. Such degrading can provide a user with a link to a merchant's web site or to other items. (See application, p.7, ll.12-24). As stated in the Office Action, Hoang *et al.* does not mention degrading the information contained in the local commerce site. (See Office Action dated June 9, 2005, p.4) Accordingly, Hoang *et al.* does not teach or suggest *degrading items on a list when the items are removed from storage within a database*, as recited in the subject claim.

The Office Action takes official notice to the fact that it is "old and well known in the art at the time of the invention to update local databases with current information received during a search" and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to degrade the information. However, as discussed above and as interpreted in the Final Office Action dated May 10, 2004, degrading includes presenting an alternative item to a buyer when a merchant removes an item from an information database. (See Final Office Action dated May 10, 2004, p.5). Degrading includes presenting information for alternate items, not just updating information for an item in the database. Applicants respectfully traverse the aforementioned well-known statements and request that the Examiner cite a reference in support of his position pursuant to MPEP 2144.03 if the rejection of the independent claims is maintained.

Claim 3 recites a custom input component that allows a user to add a custom element to the item list, the custom element not residing in any of the at least one database and claim 4 recites a user interface component that receives data related to the custom element from a user,

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the data comprises at least one of structured and unstructured data. The Office Action states that Hoang *et al.* does not teach personal requests for items other than products available from merchants. However, the Office Action takes official notice to the fact that "it was old and well known in the art at the time of the invention to provide gifts that are not store bought and providing personalized requests over the internet" and that it would have been obvious to a person having ordinary skill in the art to include "permitting a giftee to add personalized gift items to the registry." Applicants respectfully traverse the aforementioned well-known statements and request that the Examiner cite a reference in support of his position pursuant to MPEP 2144.03 if the rejection of the independent claims is maintained.

### **III. Rejection of Claims 6, 7, 10 and 11 Under 35 U.S.C. §103(a)**

Claims 6, 7, 10 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hoang *et al.* in view of Robertson (U.S. 6,609,106). Withdrawal of this rejection is respectfully requested for at least the following reasons. Claims 6, 7, 10 and 11 depend from claim 1. As discussed in detail above, Hoang *et al.* fails to suggest or teach each element of claim 1. Robertson fails to make up for the aforementioned deficiencies of Hoang *et al.* (*See Abstract*). Therefore, Hoang *et al.* and Robertson, alone or in combination, do not teach or suggest all the limitations of the subject claims and this rejection should be withdrawn.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, *to modify the reference or to combine reference teachings*. Second, there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations*. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

As discussed above, the subject invention includes an interface component that obtains item references from the item list database in response to a request to display the item

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and utilizes the references to extract related data from the information database(s). Robertson does not describe, teach or suggest such claimed aspects. Rather, Robertson is directed to accessing a registrant's pre-stored "Wish" list located at a Gift Registry site. (See Abstract). In particular, Robertson discloses a registrant of the Gift Registry site connects to Service Providers that are also registered with the Gift Registry site and registers items of interest from the Service Providers in a centralized "Wish" list database at the Gift Registry site or a local "Wish" list database, which is transferred to the Gift Registry site and saved within the centralized "Wish" list database. (See col.11, ll.25-34; col.12, ll.17-38). Robertson further discloses that a gift purchaser who desires to purchase an item for the registrant locates either the registrant or a registered occasion associated thereto, and the Gift Registry site "displays" the "Wish" list or a filtered "Wish" list to the gift purchaser. (See col.15, ll.50-62). If desired, the purchaser can select an item from the displayed "Wish" list in order to display more information about the item. (See col.15, ll.59-60). Hence, Robertson discloses a gift registry site that maintains a registrant's "Wish" list, "displays" at least a portion thereof to a purchaser, and facilitates purchasing one or more of the items from the "Wish" list. However, Robertson does not contemplate a component that retrieves item references from one database in response to a user request, utilizes the retrieved references to extract item-related data from a different database(s), and employs the extracted data to create and provide a user with a list of requested items, as recited in the subject claim. Consequently, Hoang *et al.* and Robertson, alone or in combination, do not teach or suggest all the limitations of the subject claims and this rejection should be withdrawn.

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CONCLUSION


The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP151US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin  
Reg. No. 40,894

AMIN & TUROCY, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731